

30 JUN 2002



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In re Application of :
SAIDI, Zahir et al :
Application No.:10/019,100 : DECISION ON RENEWED
PCT No.: PCT/US99/14351 :
Int. Filing Date: 24 June 1999 : PETITION UNDER
Priority Date: 26 June 1998 :
Attorney's Docket No.: P24,800-A USA : 37 CFR 1.137(b)
For: AQUEOUS COMPOSITIONS :
CONTAINING CORTICOSTEROIDS :
FOR NASAL AND PULMONARY :
DELIVERY :
:

This is in response to the "Renewed Petition Under 37 C.F.R. § 1.137(b)" filed on 15 May 2002.

BACKGROUND

In a decision dated 26 April 2002, the Office dismissed the petition submitted on 20 December 2000. The decision stated that petitioner did not establish that the entire period of abandonment was unintentional, because petitioner did not supply information from LDS regarding its failure to timely enter the national stage in the United States.

On 15 May 2002, applicant filed the instant renewed petition under 37 C.F.R. § 1.137(b).

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

As stated in MPEP 711.03(c), "where the applicant permits a third party (whether a partial assignee, licensee, or other party) to control the prosecution of an application, the third party's decision whether to file a reply to avoid abandonment is binding on the applicant." In the renewed petition filed on 15 May 2002, petitioner has neither supplied information from LDS regarding its failure to timely enter the national stage in the United States nor adequately explained why LDS was not responsible for it at the time of the abandonment. The renewed petition, on page 2, third paragraph indicates that "LDS transferred its interest in the application on August 15, 2000 to Athena Neurosciences, Inc., a wholly owned subsidiary of Elan Corporation, plc, on whose behalf the petition was filed." However, Petitioner's statements from the petition submitted on 20 December 2001 contradicts his premise that LDS was not responsible for controlling prosecution of the international application because it states on page 3, first full paragraph, "[E]arlier this year [2001], responsibility for the U.S. priority application on which the PCT application is based and the PCT and other applications stemming therefrom, as well as other patent cases that were acquired by Elan's subsidiary from LDS was transferred from LDS's patent counsel to the firm undersigned."

DECISION

For reasons above, the petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.137(b) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Failure to timely submit the proper reply will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.137(b)."

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Office of PCT Legal Administration, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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